

O-332-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2543922  
BY  
CREDIT CARD ASSET MANAGEMENT LIMITED  
TO REGISTER THE TRADE MARK**

**OPUS**

**IN CLASSES 9, 16 AND 36**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 100890  
BY  
OPUSCAPITA GROUP OY**

## Background and pleadings

1. Credit Card Asset Management Limited (“the applicant”) applied for the trade mark OPUS (number 2543922) on 7 April 2010. The application was published in the *Trade Marks Journal* on 28 May 2010, following which it was opposed by OpusCapita Group Oy (“the opponent”).

2. The following goods and services are applied for:

Class 09: *Credit cards; encoded plastic credit cards, magnetic plastic credit cards and plastic credit cards incorporating machine-readable codes.*

Class 16: *Plastic credit cards (other than magnetic or encoded plastic cards or those incorporating machine-readable codes); printed matter relating to credit cards.*

Class 36: *Credit card services. pension scheme services; pension consultancy and pension investment management; issuing of tokens of value; research into the provision of information on the availability, identity, quality and prices of financial and insurance services including the location and purchase of same; including the provision of the aforementioned services via the Internet.*

3. The opposition is brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Section 5(2)(b) states:

“(2) A trade mark shall not be registered if because –

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The ground is based upon all the goods and services of the opponent’s earlier registered Community trade mark:

5299524

**OpusCapita**

Colour claimed: red.

*Class 09: Computer software, programs and applications related to finance management, monetary transactions, treasury management, banking and customer service; electronical, magnetical and optical data media for storing computer software, programs and applications related to finance management, monetary transactions, treasury management, banking and customer service; publications, user's guides and manuals in electronic form related to computer software, programs and applications related to finance management, monetary transactions, treasury management, banking and customer service.*

*Class 16: Publications, user's guides and manuals related to software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service; instructional and educational material (except apparatus) related to software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service.*

*Class 36: Banking and treasury services, credit institution services.*

*Class 41: Education services and arrangement of education related to software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service.*

*Class 42: Consultation services and customer guidance related to software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service; computer programming services related to software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service; design, maintenance and updating services for software, programs and applications for finance management, monetary transactions, treasury management, banking and customer service; design, maintenance and updating services for software, programs and applications enabling the use of software, programs and applications related to finance management, monetary transactions, treasury management, banking and customer service as well as the user's guides and manuals related to said software, programs and applications via/over Internet by an online and/or an offline connection from the terminal of the user to the server of the service provider.*

Date of application: 7 September 2006

Date of completion of registration procedure: 4 July 2007

5. The opponent states that it is a provider of cashflow automation solutions. It claims that there is a likelihood of confusion under section 5(2)(b) because the applicant's mark is contained within its own mark and is applied for in respect of identical or closely similar goods and services.

6. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”

The sign relied upon by the opponent is identical to its registered mark upon which it relies for the purposes of section 5(2)(b) (but without reference to colour). The opponent claims use of this sign in the UK since at least 15 December 2006, in London, in relation to cash management software. It states that it has made “substantial use” of the trade mark OpusCapita in connection with the provision of its goods and services (although only goods are listed) and therefore has acquired a reputation and goodwill in its goods and services. The applicant’s mark is likely to misrepresent to the public a common connection between the parties and may misrepresent that goods and services supplied under OPUS originate from the opponent.

7. The applicant filed a counterstatement in which it denies both that the marks are similar and that the goods and services are similar. It denies that there exists a likelihood of confusion or that use of its mark is liable to be prevented under section 5(4)(a).

8. Both sides filed evidence. The matter then came to be heard before me on 31 August 2012 when the applicant was represented by Ms Linda Harland, for Reddie & Grose, and the opponent was represented by Ms Kara Bearfield, for Forresters. Prior to the hearing, the applicant had, in a letter dated 18 July 2012, requested that the proceedings be suspended because it had made an application at the Office for Harmonisation in the Internal Market to revoke the opponent’s registration on the grounds of non-use. I refused the suspension request in a letter dated 25 July 2012 because, even if the revocation action were to be successful, the earliest date on which rights would cease to exist would be 5 July 2012. At the date on which the trade mark application was made (7 April 2010), the rights in the Community trade mark would have been extant on the register and, consequently, revocation from 5 July 2012 would not affect its validity as at 7 April 2010. The opponent would be able to rely upon the Community trade mark in these proceedings whether or not part or all of it were to be revoked<sup>1</sup>. This procedural decision is open to appeal on the same timescale as the substantive decision which I give below.

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<sup>1</sup> As per the decision in Tax Assist, BL O/220/12 by Professor Ruth Annand, sitting as the Appointed Person.

## Evidence

### Opponent's evidence

9. Ms Bearfield, who is the opponent's trade mark attorney, and Mr Heikki Lansisyryja, who is the opponent's Chairman, have both filed witness statements and exhibits which are highly similar in content and structure. At the hearing, Ms Bearfield stated that the opponent did not claim any enhanced reputation (relevant to its section 5(2)(b) ground) and had filed the evidence in relation to genuine use in the UK (which it does not have to prove) and its claim to goodwill (for its section 5(4)(a) ground). Ms Bearfield conceded at the hearing that the opponent's section 5(4)(a) ground does not take it any further than under section 5(2)(b) (and is considerably narrower in scope). Since both parties made submissions based upon use of their marks and the effect of this on the likelihood of confusion, I provide below a short summary of the key points from Mr Lansisyryja's statement, adding any points from Ms Bearfield's evidence which are not covered by Mr Lansisyryja's evidence.

10. Mr Lansisyryja states that the opponent has used its mark in conjunction with the provision of its services since 1990 and has provided services directly into the United Kingdom to UK based companies since as early as 5 November 2004 (the statement of grounds and Ms Bearfield's statement both give 15 December 2006 as the earliest date of use). Mr Lansisyryja explains that the opponent's principal business is the provision of software to facilitate electronic banking. UK turnover figures for the years preceding the date of application (7 April 2010) are (given in Euros) are €1890 in 2004, €15910 in 2005, €70077 in 2006, €319 in 2007, €30861 in 2008 and €217809 in 2009. Advertising expenditure figures (given in pounds sterling) are £18650 in 2006, £9500 in 2007, £24000 in 2008 and £9950 in 2009. Mr Lansisyryja refers to advertisements being placed in a British Journal called *Treasury Today*. He states that the opponent has supplied software and services to the following clients in the UK since 5 November 2004: Select Service Partner UK Ltd; Michelin Tyres Plc/Michelin Services Ltd, Manchester, Metsäliitto Group, UK; Finpro UK and Wipak UK Ltd. Ms Bearfield also includes CitiBank London in this list. Exhibit 5 includes documentation in the form of tenders, proposals and offers to potential purchasers in the UK. Many of the invoices appear to be to the opponent rather than from it, in relation to advertising it has purchased. There are invoices to Michelin, in Stoke-on-Trent, for "software upgrade" and "software assurance", and to Select Service Partner UK for "installation of licences for "Treasury Management" and "OpusCapita Liquidity Management" and "education". Other items on the invoices are unspecified or are in Finnish. Mr Lansisyryja states that the opponent has a reputation as one of the leading providers of electronic banking and cash flow automation solutions.

## Applicant's evidence

11. Allan Silverman, who is the applicant's managing director, has provided a witness statement and exhibits. Mr Silverman explains the nature of the applicant's business under the OPUS mark as being the operation of closed credit card schemes. These are credit card schemes which the credit company (e.g. a bank) has decided to withdraw because, for example, a new scheme is on offer on different terms. The original schemes still need to be operated whilst there are customers with accounts from the original schemes. The applicant procures and services such closed schemes. In the instant case, the original credit card scheme was operated by another company under the trade mark 'Citi'. The applicant took over the scheme in November 2010, rebranding it OPUS. Mr Silverman states that OPUS marks "are quite common in the financial services area"; he exhibits the examination report<sup>2</sup> for the contested application, showing that the examiner had raised twenty-four earlier marks, which include OPUS, as notifications<sup>3</sup>. Mr Silverman states that, since the applicant's use of OPUS began in November 2010, he has not become aware of any instances of confusion with any goods and services offered under the opponent's trade mark.

12. The opponent filed observations in reply, which I will not summarise here, since they form submission rather than fact, but I will, of course, bear them in mind.

## **Decision**

13. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

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<sup>2</sup> Exhibit CY2.

<sup>3</sup> The details of the application were 'notified' to the holders of the earlier marks.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

## Comparison of goods and services

14. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

15. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

16. If goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the General Court (“GC”) in *Gérard Meric v OHIM*, case T-133/05.

17. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Jacob J also said, in *Treat*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.



18. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

19. The opponent’s mark had been registered for less than five years at the date on which the application was published and is therefore not subject to the proof of use provisions<sup>4</sup>. Assessing levels of similarity between the parties’ goods and services is ultimately a question of trade mark law, for the decision-taker to decide. It is an assessment on the basis of notional and fair use across the breadth of the goods and services. I will make the comparison by grouping together the applicant’s goods or services if they are susceptible to common reasoning<sup>5</sup>.

20. *Credit cards; encoded plastic credit cards, magnetic plastic credit cards and plastic credit cards incorporating machine-readable codes (class 9); plastic credit cards (other than magnetic or encoded plastic cards or those incorporating machine-readable codes); printed matter relating to credit cards (class 16); credit card services (class 36)*

The opponent’s term *banking* covers services provided by banks. Such services include credit card services. The applicant’s *credit card services* are identical to the opponent’s *banking* services. Credit cards are indispensable for the operation of credit card services. The applicant’s *Credit cards; encoded plastic credit cards, magnetic plastic credit cards and plastic credit cards incorporating machine-readable codes (class 9); plastic credit cards (other than magnetic or encoded plastic cards or those incorporating machine-readable codes)* are of the highest level of similarity to the opponent’s *banking* services. Banks display (in

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<sup>4</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

<sup>5</sup> As per the decision of Mr Geoffrey Hobbs Q.C., sitting as the appointed person, in *Separode Trade Mark* BL O/399/10.

branches or online) printed information about their credit card services. Consumers will want the information before they commit to taking out a new credit card. The printed matter relating to credit cards is complementary to the credit card service provided by the bank and, obviously, is from an identical source to the service. There is a very high level of similarity between the applicant's *printed matter relating to credit cards* and the opponent's *banking services*.

21. *Pension scheme services; pension consultancy and pension investment management;*

The opponent's best case against these services lies with its term *banking*. 'Banking' is (applying *Avnet*) a rather general phrase. Its core meaning is the sort of services one would expect to be available from a bank. The most basic form of banking is the depositing and withdrawal of funds, and the provision of credit (loans). Private pensions are based on savings and investment. There is a choice for the consumer as to whether, for example, he saves for retirement by investing in bonds and stocks and shares at the bank or building society or whether he does that via a pension scheme provided by a specialist company. There is competition between pension schemes provided by such companies and investment services provided by banks. It is possible that banks also provide pension services, but there is no evidence of this before me and I would regard including pensions within banking as stretching its core meaning further than advised in *Avnet* and *Treat*. Owing to the competitiveness between banks and pension providers in relation to investment choices, the shared users and purpose (saving for retirement), there is a good degree of similarity between the applicant's *pension scheme services* and the opponent's *banking services*. The applicant's *pension consultancy and pension investment management services* are closely allied to the pension scheme services themselves; there is also a good degree of similarity between the applicant's *pension consultancy and pension investment management services* and the opponent's *banking services*.

22. *Issuing of tokens of value;*

Tokens of value include, for example, travellers cheques, and vouchers, such as gift vouchers or those used in relation to incentive, discount or loyalty schemes. Banking, treasury/cash management<sup>6</sup> and credit institution<sup>7</sup> services are all services which deal with the issuing of such tokens of value. Tokens of value also denote a system of coinage in which the coins have a value that is much

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<sup>6</sup> The online Financial Times Lexicon gives *treasury* as another name for cash management.

<sup>7</sup> The 10<sup>th</sup> Edition of the World Intellectual Property Organisation International Classification of Goods and Services Explanatory Note to Class 36 describes credit institutions other than banks as being, for example, co-operative credit associations, individual financial companies and lenders.

higher than the value of the metal they contain. The applicant's *issuing of tokens of value* is identical to the opponent's class 36 services.

23. *Research into the provision of information on the availability, identity, quality and prices of financial and insurance services including the location and purchase of same; including the provision of the aforementioned services via the Internet.*

These services are the services undertaken by financial advisors, provided by every bank and building society. They are part and parcel of *banking* and are covered by that term. Consequently, they are identical to the opponent's *banking* services.

#### Average consumer and the purchasing process

24. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. For both parties, the average consumer for some goods and services will be the general public (e.g. banking, credit cards and financial information). For other goods and services, it will be business professionals (e.g. the opponent's software goods and services) who will pay close attention to the selection of the goods and services. The purchasing process for credit cards and credit services, and the opponent's computer goods and related services is primarily visual as research will be undertaken before commitment is made. For banking, it will be a combination of visual and aural purchasing; the telephone is a common medium through which to access banking services, but no more usual than internet banking and attendance in a physical branch.

#### Comparison of trade marks

25. The marks to be compared are:

| Opponent's mark   | Applicant's mark |
|---|------------------|
|  | OPUS             |

26. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

27. The distinctive and dominant element of the applicant's mark is OPUS as that is the only element in the mark. The opponent's mark contains a capital C halfway along. Ms Harland submitted that the opponent's mark is not a conventional word because of the presence of the capital C in the middle. I agree with that (but not with her submission that because of the capital C the marks are visually very different). The effect of the C is to split the opponent's mark into two distinct elements: OPUS and CAPITA. OPUS is the more dominant of the two, despite being the shorter, because it sits at the beginning of the mark. There is a rough rule of thumb that the beginnings of marks are important in the perception of marks by the average consumer because this is the part that first strikes the consciousness. To put the rule of thumb into perspective, if the beginning of the mark consists of an element which is a descriptive or common combining form, the importance may be reduced<sup>8</sup>. In this case, the beginning of the opponent's mark is OPUS which is not descriptive and is not a common combining form. OPUS is important as a first element and, contrary to Ms Harland's view, it does not matter whether it is the beginning of the earlier mark or the beginning of the later mark: confusion works both ways<sup>9</sup>. As a consequence of the position of OPUS in the opponent's mark, there is a good deal of visual and aural similarity between the marks. The separation caused by the capital C also means that there is a good deal of visual similarity because it is 'picked out' in the mark. The claim to the colour red, as recorded on the details for the opponent's mark on the Community trade mark register, makes no difference to the visual similarity because the applicant's mark makes no claim that it has colour as a feature. This means that I should compare it as though it were also in the colour of the registered mark<sup>10</sup>. Colour is therefore not an issue which affects the comparison of the trade marks.

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<sup>8</sup> *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07.

<sup>9</sup> *Omega v OHIM*, GC, Case T-90/05, paragraph 43: "In any event, even if the Board of Appeal should have examined specifically whether there was a likelihood of confusion in the light of the goods connected with the measurement of time, and even if it were established that the applicant's trade mark is reputed for the goods thus described, the applicant's argument cannot succeed. The fact that the relevant public may possibly associate the trade mark OMEGA with the applicant because it is allegedly well known cannot in any way exclude the existence of a likelihood of confusion in the present case, since the relevant public could be led to believe that the goods covered by the earlier mark are produced by the applicant."

<sup>10</sup> In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated: "119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is

28. Ms Bearfield included some dictionary definitions in her skeleton argument relating to the meanings of OPUS and CAPITA. Both she and Ms Harland agree that OPUS usually refers to the work of a composer (it is the Latin word for ‘a work’). I doubt whether that meaning is known widely to the average consumer or, if it is known, it would not be a concept which would be immediately brought to mind in the context of the parties’ goods and services. CAPITA is not an English word. It is met in the context of the Latin *per capita*, meaning ‘by head’, used to denote a quantity per individual person. Without the ‘per’, and particularly in conjunction with another element (OPUS) instead of ‘per’, I doubt whether this meaning would spring immediately to mind, even in the context of financial goods and services. Both parties’ marks are likely to be viewed as invented. They are conceptually neutral.

#### Distinctiveness of the earlier mark

29. It is necessary to consider the distinctive character of the opponent’s mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion<sup>11</sup>. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public<sup>12</sup>. Ms Bearfield stated at the hearing that the opponent did not claim an enhanced reputation through use, so I will only consider the position on the basis of inherent distinctive character. Ms Harland submitted that the prevalence of OPUS marks on the register (to which Mr Silverman’s evidence referred) meant that OPUS is lacking in distinctive character for financial goods and services (Ms Harland referred to the American concept of dilution). Firstly, the co-existence of marks on the register (some of which are expired or are registered for different goods and services) tells one very little about whether a mark is common because there is no information as to whether any of the marks have been used. Secondly, not all of the marks are on the register for the same or similar goods or services. Neither Opus nor Capita describes or alludes to the goods and services for which the opponent’s mark is registered. The combination of the two elements has a high level of distinctive character.

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to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

<sup>11</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>12</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

## Likelihood of confusion

30. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

31. The applicant has said that it is unaware of any instances of confusion between the parties' marks since it began use of OPUS in November 2010. Ms Harland submitted that there was no likelihood of confusion if the marks have been used side-by-side and no confusion has occurred. The parties' evidence does not show side-by-side use. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. There must be evidence to suggest that the relevant public has shown that it distinguishes between the parties' goods and services. The opponent's evidence is centred on cash management software systems and the applicant's evidence shows use on a closed credit card scheme which, as the applicant itself points out, cannot expand because it is closed. This does not show concurrent use in a market where the public has become used to distinguishing between the undertakings. There is no automatic entitlement to a registration simply because a mark has been used. Further, the applicant cannot speculate, on the basis of historical use, as to what goods and services the opponent may choose to use its mark upon in the future (assuming it is not revoked) or, if it assigned the mark to another proprietor, what use that proprietor may make of the mark. This is the principle of notional and fair use; my assessment under section 5(2)(b) as to the likelihood of confusion must be in relation to the notional coverage of the parties' specifications, not their use to date<sup>13</sup>. The submissions in relation to the other OPUS marks on the register do not help the applicant for the reasons I have already given.

32. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer

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<sup>13</sup> *Oakley, Inc v OHIM* Case T-116/06. "76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).

perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I think it unlikely that the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods or services bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective goods or services come from the same or economically linked undertakings<sup>14</sup>, there is a likelihood of confusion. This is often called ‘indirect confusion’, but it is, nevertheless, confusion within the meaning of section 5(2)(b) of the Act. Mr Iain Purvis QC, sitting as the appointed person in *L.A. Sugar Trade Mark* BL O/375/10<sup>15</sup> explained indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”*.”

33. The italicised part of Mr Purvis’ explanation neatly describes the problem for the applicant’s mark: it is different to the opponent’s mark but it has the identical dominant and distinctive element in common with it. There is distinct potential, bearing in mind that confusion works both ways, for OPUS to be viewed as a house mark and OpusCapita to be seen as a subsidiary product or service, or a related undertaking. There is a good deal of visual and aural similarity between the marks and they are neither similar nor dissimilar conceptually. Conceptual differences between marks (even where only one mark has a meaning) can offset visual and phonetic similarity<sup>16</sup>, but there is no concept here to operate upon the consumer’s perception of the marks. Notwithstanding the high level of attention of the average consumer for some of the goods and services, there is a likelihood of confusion in relation to all of the applicant’s goods and services.

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<sup>14</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

<sup>15</sup> All BL-prefixed decisions are available for viewing on the Intellectual Property Office’s website.

<sup>16</sup> *Ruiz-Picasso v OHIM*, case 361/04 P [2006] E.T.M.R. 29

### Section 5(4)(a)

34. The opponent has succeeded under section 5(2)(b) against all of the applicant's goods and services. Consequently, there is no need to consider this ground as the outcome could not be any better for the opponent than under section 5(2)(b) (especially since the section 5(4)(a) ground is founded upon a much narrower range of goods).

### **Outcome**

**35. The opposition succeeds in relation to all the goods and services of the application. The application is refused.**

### **Costs**

36. The opponent has been successful and is entitled to an award of costs, according to the published scale. I will reduce the evidence award because Ms Bearfield's evidence was almost identical to that of Mr Lansisyrja, but the applicant was still put to the trouble of considering the two sets. The hearing took little time and this is reflected in that portion of the award.

|  |              |
|--|--------------|
| Preparing a statement and considering the counterstatement | £200         |
| Opposition fee   | £200         |
| Filing evidence and considering the applicant's evidence   | £500         |
| Preparing for and attending a hearing                      | £250         |
| Total:   | £1150        |
| <b>Total</b>   | <b>£1150</b> |



37. I order Credit Card Asset Management Limited to pay OpusCapita Group Oy the sum of £1150. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this**

**05 day of September 2012**

**Judi Pike  
For the Registrar,  
the Comptroller-General**